

PCT

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Akihiro MURATA et al.

Application No.: 09/509,669

Filed: April 4, 2000

For: OPTICAL MODULE



ATTN: PCT Branch

Docket No.: 105895

#8  
8/9/00  
anw

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

UNDER 35 U.S.C 371 IN THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)  
DECLARATION ALREADY FILED

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

In response to the Notification of Missing Requirements Under 35 U.S.C 371 in the United States Designated/Elected Office (DO/EO/US) (copy attached) mailed on May 8, 2000, the executed Declaration of the inventors was filed on April 4, 2000. A copy of the executed Declaration as filed, a copy of the Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371, and a copy of the stamped postcard receipt are attached hereto. The surcharge for providing the oath or declaration is not believed to be due since the Declaration was filed before the appropriate 20 or 30 months from the priority date.

Entry of these documents on April 4, 2000 should have completed all of the filing formalities. Accordingly, prompt issuance of a Notification of Acceptance and Filing Receipt, and prompt examination and allowance of this application are respectfully solicited.

The Director is hereby authorized to charge any additional fee (or credit any overpayment) associated with this communication to Deposit Account No. 15-0461. Two duplicate copies of this paper are attached.

Respectfully submitted,

James A. Oliff  
Registration No. 27,075

RECEIVED  
U.S. PATENT AND TRADEMARK OFFICE  
JUN 08 2000  
105895

Thomas J. Pardini  
Registration No. 30,411

JAO:TJP/kmc

Date: June 8, 2000

OLIFF & BERRIDGE, PLC  
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DEPOSIT ACCOUNT USE  
AUTHORIZATION  
Please grant any extension  
necessary for entry;  
Charge any fee due to our  
Deposit Account No. 15-0461

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: ASSISTANT COMMISSIONER FOR PATENTS

Box PCT

Washington, D.C. 20231

|   |                       |  |
|---|-----------------------|--|
| U.S. APPLICATION NO.                                      | FIRST NAMED APPLICANT | ATTY. DOCKET NO.   |
| 09/509669   | MURATA                | A 105895   |
| OLIFF & BERRIDGE<br>P O BOX 19928<br>ALEXANDRIA, VA 22320 | MAY 09 2000           | INTERNATIONAL APPLICATION NO.<br>PCT/JP99/03927                                |
|   |                       | I.A. FILING DATE 22 JUL 99 PRIORITY DATE 05 AUG 98<br>DATE MAILED: 08 MAY 2000 |

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as

a Designated Office (37 CFR 1.494),  
 an Elected Office (37 CFR 1.495):  
 U.S. Basic National Fee.  
 Copy of the international application in:  
 a non-English language.  
 English.  
 Translation of the international application into English.  
 Oath or Declaration of inventors(s) for DO/EO/US.  
 Copy of Article 19 amendments.  
 Translation of Article 19 amendments into English.  
 The International Preliminary Examination Report in English and its Annexes, if any.  
 Translation of Annexes to the International Preliminary Examination Report into English.  
 Preliminary amendment(s) filed 31 mar 2000 and \_\_\_\_\_  
 Information Disclosure Statement(s) filed \_\_\_\_\_ and \_\_\_\_\_  
 Assignment document.  
 Power of Attorney and/or Change of Address.  
 Substitute specification filed \_\_\_\_\_.  
 Verified Statement Claiming Small Entity Status.  
 Priority Document.  
 Copy of the International Search Report  and copies of the references cited therein.  
 Other:

2. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

a. Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.  
 The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.  
 b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).  
 c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.  
 The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.  
 d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

3. Additional claim fees of \$ \_\_\_\_\_ as a  large entity  small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due. See attached PTO-875.**ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY  21 OR  31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

4. Translation of the Annexes **MUST** be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.5.  The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR. 494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

***A copy of this notice MUST be returned with this response.***

Enclosed:

 PCT/DO/EO/917  
 PTO-875 Notice of Defective Translation

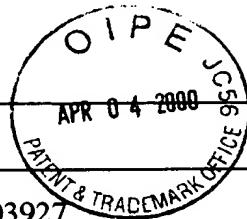
FORM PCT/DO/EO/905 (December 1997)

SHELBY VIGIL, PARALEGAL  
Telephone: 703-305-3653*SVJ*

**PTO RECEIPT FOR FILING OF PAPERS**

**The following papers have been filed:**

PCT Transmittal, exec. Declaration.



**Name of Applicant:** Akihiro MURATA et al.

**Serial No.:** U.S. National Stage of PCT/JP99/03927

**Atty. File No.:** 105895

**Title (New Cases):** OPTICAL MODULE

**Sender's Initials:** JAO:TJP/kmc

284/24

**PATENT OFFICE DATE STAMP**

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APR 25 2000  
U.S. MAIL ROOM

**COPY TO BE STAMPED BY PATENT OFFICE  
AND RETURNED BY MESSENGER**

Seiko Epson Ref. No.: F004518US00

Attorney's Ref. No.:

**Declaration and Power of Attorney For Patent Application**

特許出願宣言書及び委任状

**Japanese Language Declaration**

日本語宣言書

下記の氏名の発明者として、私は以下の通り宣言します。

私の住所、私書箱、国籍は、下記の私の氏名の後に記載された通りです。

下記の名称の発明に関して請求範囲に記載され、特許出願している発明内容について、私が最初かつ唯一の発明者（下記の氏名が一つの場合）もしくは最初かつ共同発明者であると（下記の名称が複数の場合）信じています。

**光モジュール**

上記発明の明細書（下記の欄で×印がついていない場合は、本書に添付）は、

1999年7月22日に提出され、米国出願番号または  
特許協定条約国際出願番号をPCT/JP99/03927とし、  
(該当する場合) \_\_\_\_\_に訂正されました。

私は、特許請求範囲を含む上記訂正後の明細書を検討し、内容を理解していることをここに表明します。

私は、連邦規則法典第37編第1条56項に定義されるとおり、特許資格の有無について重要な情報を開示する義務があることを認めます。

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**OPTICAL MODULE**

the specification of which is attached hereto unless the following box is checked:

was filed on July 22, 1999  
as United States Application Number or  
PCT International Application Number  
PCT/JP99/03927 and was amended on  
\_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

## Japanese Language Declaration

### (日本語宣言書)

私は、米国法典第35編119条(a)-(d)項又は365条(b)項に基き下記の、米国以外の国の少なくとも1ヶ国を指定している特許協力条約365条(a)項に基づく国際出願、又は外国での特許出願もしくは発明者証の出願についての外国優先権をここに主張するとともに、優先権を主張している、本出願の前に出願された特許または発明者証の外国出願を以下に、枠内をマークすることで、示しています。

I hereby claim foreign priority under Title 35, United States Code, Section 119 (a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed.

#### Prior Foreign Application(s)

##### 外国での先行出願

|                               |                            |   |                          |
|-------------------------------|----------------------------|---|--------------------------|
| 10-233608<br>(Number)<br>(番号) | Japan<br>(Country)<br>(国名) | 05/August/1998<br>(Day/Month/Year Filed)<br>(出願年月日) | <input type="checkbox"/> |
| (Number)<br>(番号)              | (Country)<br>(国名)          | (Day/Month/Year Filed)<br>(出願年月日)                   | <input type="checkbox"/> |

##### Priority Not Claimed

##### 優先権主張なし

私は、第35編米国法典119条(e)項に基いて下記の米国特許出願規定に記載された権利をここに主張いたします。

I hereby claim the benefit under Title 35, United States Code, Section 119 (e) of any United States provisional application(s) listed below.

|                             |                        |
|-----------------------------|------------------------|
| (Application No.)<br>(出願番号) | (Filing Date)<br>(出願日) |
|-----------------------------|------------------------|

|                             |                        |
|-----------------------------|------------------------|
| (Application No.)<br>(出願番号) | (Filing Date)<br>(出願日) |
|-----------------------------|------------------------|

私は下記の米国法典第35編120条に基いて下記の米国特許出願に記載された権利、又は米国を指定している特許協力条約365条(c)に基づく権利をここに主張します。また、本出願の各請求範囲の内容が米国法典第35編112条第1項又は特許協力条約で規定された方法で先行する米国特許出願に開示されていない限り、その先行米国出願書提出日以降で本出願書の日本国内または特許協力条約国提出日までの期間中に入手された、連邦規則法典第37編1条56項で定義された特許資格の有無に関する重要な情報について開示義務があることを認識しています。

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s), or 365 (c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of application:

|   |  |
|---|--|
| PCT/JP99/03927<br>(Application No.)<br>(出願番号) | 22/July/1999<br>(Filing Date)<br>(出願日) |
|---|--|

|  |
|--|
| Pending<br>(Status: Patented, Pending, Abandoned)<br>(現況: 特許許可済、係属中、放棄済) |
|--|

|                             |                        |
|-----------------------------|------------------------|
| (Application No.)<br>(出願番号) | (Filing Date)<br>(出願日) |
|-----------------------------|------------------------|

|   |
|---|
| (Status: Patented, Pending, Abandoned)<br>(現況: 特許許可済、係属中、放棄済) |
|---|

私は、私自身の知識に基づいて本宣言書中で私が行なう表明が真実であり、かつ私が入手した情報と私の信じるところに基づく表明が全て真実であると信じていること、さらに故意になされた虚偽の表明及びそれと同等の行為は米国法典第18編第1001条に基づき、罰金または拘禁、もしくはその両方により処罰されること、そしてそのような故意による虚偽の声明を行なえば、出願した、又は既に許可された特許の有効性が失われることを認識し、よってここに上記のごとく宣誓を致します。

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

## Japanese Language Declaration

(日本語宣言書)

委任状： 私は、下記の発明者として、本出願に関する一切の手続きを米特許商標局に対して遂行する弁理士または代理人として、下記の者を指名いたします。（弁護士、または代理人の氏名及び登録番号を明記のこと）

James A. Oliff, (Reg. 27,075)  
 William P. Berridge, (Reg. 30,024)  
 Kirk M. Hudson, (Reg. 27,562)  
 Thomas J. Pardini, (Reg. 30,411)  
 Edward P. Walker, (Reg. 31,450)  
 Robert A. Miller, (Reg. 32,771)  
 Mario A. Costantino, (Reg. 33,565)  
 Caroline D. Dennison, (Reg. 34,494)

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. (list name and registration number)

書類送付先：  
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 P.O. Box 19928  
 Alexandria, Virginia 22320

Send Correspondence to:  
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 P.O. Box 19928  
 Alexandria, Virginia 22320

直接電話連絡先： (名前及び電話番号)  
 OLIFF & BERRIDGE, PLC  
 (703) 836-6400

Direct Telephone Calls to: (name and telephone number)  
 OLIFF & BERRIDGE, PLC  
 (703) 836-6400

唯一または第一発明者名

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Full name of sole or first inventor

Akihiro MURATA

発明者の署名

村田 昭浩

日付

2000年3月17日

Inventor's signature

Akihiro MURATA

Date

3-17-2000

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Residence  
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日本

Citizenship

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北村 昇二郎

Full name of second joint inventor, if any

Shojiro KITAMURA

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北村 昇二郎

日付

2000年3月17日

Second inventor's signature

Shojiro KITAMURA

Date

3-17-2000

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(第三以降の共同発明者についても同様に記載し、署名をすること)

(Supply similar information and signature for third and subsequent joint inventors.)